

REMARKS

Claims 1-7 and 9 were pending in this application. Claim 1 has been amended. Claims 3 and 5 have been canceled. The claim 1 amendments are supported, at least, by original claims 3 and 5.

The section of the specification entitled “Summary of the Invention” (consisting of one section heading and three paragraphs) has been amended and replaced. Support for the amendment to the Summary of the Invention can be found, for instance, in original claims 8 and 9.

No new matter is introduced by the foregoing amendments to the specification or claims.

After entry of this amendment claims 1, 2, 4, 6, 7, and 9 are pending in this application. Consideration of the pending claims is requested.

Telephone Interview:

Applicants thank Examiner Priebe for the courtesy of a telephone interview with their representative, Debra Gordon, on June 14, 2005. Applicants’ representative provided proposed claim amendments to the Examiner prior to the interview. The predominant discussion during the interview concerned the proposed claim amendments in the context of the rejection of claims 1-4 and 9 under 35 U.S.C. §103(a) in view of Peterson *et al.* (*Eur. J. Neurosci.*, 12(Suppl. 11):233, June 2000). No agreement was reached; however, the Examiner agreed to further consider the claim amendments when submitted in a formal amendment.

Specification Objection:

The specification has been objected to for allegedly failing to disclose the terminology “at least two months” and “at least four months.” The Office action (at page 2) provides that “[t]his terminology was present in original claims 8 and 9, respectively” Accordingly, the specification has been amended to recite the text of original claims 8 and 9 in the section entitled “Summary of Invention.” No new matter is added by including in the specification the same language found in original claims.

In view of the foregoing amendment, Applicants respectfully request that this objection to the specification be withdrawn.

Claim Rejections under 35 U.S.C. §112, 1st paragraph:

Claims 1, 2, 4-7 and 9 have been rejected under 35 U.S.C. §112, 1st paragraph (written description) because, allegedly, the specification does not identify any viral vectors, other than adeno-associated viral (AAV) vectors, that provide heterologous gene expression for “at least two months” or “at least four months.” The Examiner determines that “the specification teaches that AAV vectors meet th[e] requirement” of “expression of the heterologous gene from the viral vectors [for] at least two months” (page 4, lines 5-8 of the Office action). Consequently, the Office concedes that “[l]imiting the claims to AAV vectors . . . would overcome this rejection” (page 4, lines 17-18 of the Office action).

Applicants traverse the rejection; however, to facilitate prosecution of the application, claim 1 (and, thereby, its dependent claims) has been amended to recite, in relevant part, “. . . providing at least 1.5×10^7 infectious particles of an *adeno-associated viral vector* . . . ” (emphasis added). Pending claims 2, 4, 6, 7, and 9 each depend from claim 1, and claim 5 has been canceled. In view of these claim amendments, Applicants respectfully request that this rejection be withdrawn.

Claim Rejections under 35 U.S.C. §102:

Claims 1-4 and 9 have been rejected under 35 U.S.C. §102(e) as being allegedly anticipated by Aebischer *et al.*, U.S. Pat. No. 6,800,281 (“Aebischer”). Applicants traverse this rejection. Nevertheless, to further prosecution of the application, claim 3 has been canceled and claims 1, 2, 4, and 9 have been amended consistent with the Examiner’s suggestion to recite that the claimed viral vector is an AAV vector (last sentence of page 5 of the Office action). Aebischer does not teach an AAV vector. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Claim Rejections under 35 U.S.C. §103:

Claims 1, 2, 4-7 and 9 have been rejected under 35 U.S.C. §103(a) as allegedly being obvious in light of Horellou *et al.*, U.S. Pat. Pub. No. 2002/0031493 A1 (“Horellou”), or Finiels *et al.*, U.S. Pat. No. 6,632,427 B1 (“Finiels”), each in view of Zou *et al.*, (*Mol. Ther.* 20(2):105-113, Aug. 2000) (“Zou”). Applicants traverse this rejection. However, to further prosecution of the application, claim 5 has been canceled and claims 1, 2, 4, 6, 7, and 9 have been amended consistent with the Examiner’s suggestion to recite that the claimed viral vector is an AAV vector (page 7, line 15 of the Office action). None of Horellou, Finiels, or Zou, either alone or in combination, teaches an AAV vector. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Claims 1-4 and 9 have been rejected under 35 U.S.C. §103(a) as allegedly being obvious in light of Peterson *et al.*, (*Eur. J. Neurosci.*, 12(Supp. 11):233, Abstract 110.13, June 2002). Applicants traverse this rejection for reasons previously presented, and for the further reasons presented below.

Claim 1 (and, thereby, its dependent claims) has been amended to recite, in relevant part, “A method for transducing a *human* neuron . . . , comprising . . . providing *at least 1.5 x 10⁷ infectious particles* of an adeno-associated viral vector . . . ” (emphasis added). Peterson fails to teach, at least, transduction of human neurons and an amount of AAV vector useful in such transduction. To establish a *prima facie* case of obviousness, the Office must cite references that, among other things, teach or suggest *all* of the claim limitations (MPEP §2143 and §2143.03). Peterson does not teach at least *two features* of amended claim 1; therefore, a *prima facie* case of obviousness has not been made with regard to amended claim 1 and its dependent claims (*i.e.*, claims 2, 4 and 9).

Claim 3 has been canceled; therefore, this rejection is moot with regard to claim 3. In view of each of the foregoing claim amendments and arguments, Applicants respectfully request that this rejection be withdrawn.

Provisional Double Patenting

Claims 1-7 and 9 have been provisionally rejected under the doctrine of obviousness-type double patenting in view of claims 1-26 of copending U.S. Application No. 10/237,567.

Claims 3 and 5 have been canceled; therefore, this rejection is moot with regard to those two claims. Applicants respectfully request continued deferral of this ground for rejection of claims 1, 2, 4, 6, 7, and 9 until such time as allowable subject matter is indicated in one or both applications.

CONCLUSION

It is respectfully submitted that the present claims are in a condition for allowance. If any issues remain, the Examiner is requested to contact the undersigned attorney prior to issuance of the next Office action in order to arrange a telephone interview. It is believed that a brief discussion of the merits of the present application may expedite prosecution and allowance of the claims.

Respectfully submitted,

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